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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,304	07/30/2003	Daniel R. Morris	037925.0002	8729

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12/22/2008

EXAMINER

MEYERS, MATTHEW S

ART UNIT	PAPER NUMBER
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3689

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/629,304		MORRIS, DANIEL R.	
	Examiner		Art Unit	
	Matthew S. Meyers		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to applicant's communication on 11/1/2007, wherein claims 1-30 are currently pending.

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statements (IDSs) submitted are being considered by the examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinberg et al. (Pub. No.: US 2002/0107703) (Hereinafter referred to as Feinberg) in

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view of *MERS aids electronic mortgage market*, Mortgage Banking, January 1997

(Hereinafter referred to as MERS II). With respect to **Claims 1 and 30**:

Feinberg discloses a computer-assisted method and an article of manufacture comprising a computer instruction carrier, readable by a computer, tangibly embodying one or more instructions executable by the computer to perform a method for managing lien releases (Feinberg [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset."), comprising the steps of:

providing a computer system for assisting with loan settlements having a database of trigger documents (Feinberg [0013], "A medical lien is then created by a separate software program 50 from the data on the database 40... The content and format of the document are specified by the guidelines stored in the database 40.") (Examiner interprets the documents stored in the database to be trigger documents which is consistent with application definition for in his specification on page 27 which defines trigger documents as, "Trigger documents can also vary in substance, and can include release date notices, demand letters, payoff orders, notices of intent to release and any other documents useful to users of the present invention... The database of trigger documents can include those described earlier, such as demand letters intended for lien 20 holders and legal forms adapted to the jurisdiction associated with a given lien, as described earlier.".);

providing access to at least one database of lien records to a user of an input device (Feinberg [0006], "It is a further object of this invention to provide a lien management system which operates on a computer network to accommodate multiple clients, recording agencies, and changing recording guidelines.");

identifying, by the computer system based on input from the input device, a lien (Feinberg [abs], "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.");

calculating, by the computer system, at least one trigger date associated with said lien, the trigger date indicative of when the lien is required to be released by a lien holder associated with the lien (Feinberg Fig 3, [0013], "The recording agency 60 reviews the document for proper format and content. If acceptable, the recording agency records the medical lien, giving it a recording number and a recording date." and Claim 7) (Examiner is interpreting the trigger date as defined in applicant's specification at page 27, "The trigger date calculation can be jurisdiction-specific. For example, some jurisdictions may calculate deadlines for payoff lender releases of liens based on the date of settlement, others based on payoff date, and so forth. In another embodiment, the trigger date can be calculated based on an overdue release date. Statutory 25 requirements can be stored in a database accessible to the settlement agent

and other entities identified above via network connection, for example, and such statutory requirements can be updated on an individual jurisdictional basis.”);

issuing at least one trigger document. Feinberg teaches “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.” (Feinberg [0016])

Feinberg discloses the above limitations. Feinberg additionally discloses once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.” (Feinberg [0016]). However, Feinberg does not explicitly disclose the determining, by computer step that the lien is required to be released by a lien holder associated with the lien. MERS II teaches determining, by the computer system, that the property-related lien is required to be released and has not been released by the trigger date (MERS II, Page 5, “He notes that all parties will more easily be able to track loans to ensure that contractual obligations are being met.” and Page 6, MERS can electronically transmit payoff amounts and other release information, Maher says. Until then, they are hoping MERS will enforce lien release requirements.”).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of MERS II with Feinberg. Both references relate to lien tracking and their management. MERS II teaches about a system which generates an 18 digit mortgage identification number (MIN) for every origination. This MIN will stay with a loan throughout its life-even as ownership of the loan and its servicing changes hands. (MERS II, Page 1). The

reason for this 18 digit mortgage identification number is to prevent cases where the mortgages have been paid off but in which no one files to release the lien. Feinberg teaches a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.” (Feinberg [abs]). It would have been obvious at the time of the invention to have combined the MERS system with Feinberg in order to facilitate the management of these liens in order to avoid the pitfalls that often occur when the underlying note is bought, sold, transferred, securitized and so forth in accordance with market custom, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Additionally, Feinberg discloses managing lien releases as claimed in applicant's preamble (“Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.” Feinberg [0016]), and also discloses “The invention is applicable to the preparation, recordation, tracking and filing of many types of liens, assignments, stop notices and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset. For example, the application of this invention to healthcare provider liens is described in the preferred embodiment above, and the application of this invention to construction liens is described in the second embodiment above. Although not specifically described herein, the invention is

also applicable to agricultural liens, judgment liens, personal property liens, tax liens, innkeepers' liens, farm services lien, mechanics' or materialmen's liens, and all other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.” (Feinberg [0018], but does not explicitly disclose that the liens are property-related liens. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have applied Feinberg to any type legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

1. With respect to **Claim 2:**

Feinberg discloses wherein said step of identifying a lien includes identifying lien information including at least one of a lien holder, an obligor, a loan amount, a payee identifier and a lien jurisdiction (Feinberg [0011], “In the preferred embodiment for medical lien filing, the client is a medical service provider such as a physician, hospital, or therapist.”).

2. With respect to **Claim 3:**

Feinberg discloses wherein the step of establishing said database includes establishing demand letters to lien holders and legal forms adapted according to a jurisdiction associated with said identified lien (Feinberg [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given

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jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

3. With respect to **Claim 4:**

Feinberg discloses wherein said determining steps include the step of querying jurisdictional records (Feinberg [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

4. With respect to **Claim 5:**

Feinberg discloses wherein said trigger date is calculated by a lien payoff disbursement date (Feinberg [0002], “The process ensures that the patient or available insurance coverage pay the service or equipment provider its share of the reimbursement, once the insurance company settles or disburses finds related to the liability claim which caused the patient's injuries.” and [0007], “The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”).

5. With respect to **Claim 6:**

Feinberg discloses wherein said trigger date is calculated by a settlement date (Feinberg [0002], “The process ensures that the patient or available insurance coverage pay the service or equipment provider its share of the reimbursement, once the insurance company settles or disburses finds related to the liability claim which caused the patient's injuries.” and [0007], “The present invention provides a method and system

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for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”).

6. With respect to **Claim 7:**

Feinberg discloses wherein said trigger date is calculated by an overdue release date (Feinberg [0002], “The process ensures that the patient or available insurance coverage pay the service or equipment provider its share of the reimbursement, once the insurance company settles or disburses finds related to the liability claim which caused the patient's injuries.” and [0007], “The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”).

7. With respect to **Claim 8:**

Feinberg discloses wherein said trigger date is calculated by determining statutory requirements for lien releases based on a jurisdiction associated with said identified lien (Feinberg [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

8. With respect to **Claim 9:**

Feinberg discloses wherein said statutory requirements are stored in a database and are accessible via network connection (Feinberg, [abs], “Certain lien information is provided by a lien holder to a centralized database via the Internet.”).

9. With respect to **Claim 10:**

Feinberg discloses updating said statutory requirement database (Feinberg [0004], "Once the lien documents are properly prepared and subsequently accepted by the government...") (Examiner notes that the government agency would not accept the lien documents unless they are properly filed. Therefore, the statutory requirement database would need to be updated.).

10. With respect to **Claim 11:**

Feinberg discloses wherein said at least one trigger document is an e-mail (Feinberg [0012], "The data is transmitted using email communication protocols.").

11. With respect to **Claim 12:**

Feinberg discloses wherein said at least one trigger document is a notice to at least one of a title company or lender (Feinberg [0015], "Similarly, the lien holder is notified that the claim has been perfected.").

12. With respect to **Claim 13:**

Feinberg discloses wherein said database further includes at least one form and at least one report, said form and said report being customizable based on said identified lien (Feinberg [0017], "The present invention can be applied to other types of liens").

13. With respect to **Claim 14:**

Feinberg discloses wherein said lien is identified by receiving lien transaction information via a remote device over a network (Feinberg [0006], "It is a further object of this invention to provide a lien management system which operates on a computer

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network to accommodate multiple clients, recording agencies, and changing recording guidelines.”).

14. With respect to **Claim 15:**

Feinberg discloses wherein said step of providing access includes providing access to a plurality of lien record databases corresponding to a respective plurality of lien record-keeping jurisdictions (Feinberg [0006], “It is a further object of this invention to provide a lien management system which operates on a computer network to accommodate multiple clients, recording agencies, and changing recording guidelines.”).

15. With respect to **Claim 16:**

Feinberg discloses a computer-based system for managing lien releases (Feinberg [0018], “Although not specifically described herein, the invention is also applicable to...personal property liens...and all other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”), comprising:

a storage component having at least one trigger document stored therein (Feinberg [0012], “The server validates the data by comparing it to a set of guidelines, which have previously been stored on the database.”);

means for instructing said lien management component to issues at least one trigger document from said storage component (Feinberg [0016], “Once the lien holder has been paid, a release or satisfaction is filed to indicate the debt has been paid.”)

Feinberg discloses all the above limitations, Feinberg additionally discloses a system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset. (Feinberg [abs]). Feinberg does not explicitly disclose a lien management component having means for providing a user interface, receiving at least one lien release tracking request, identifying a lien corresponding to said request, and calculating at least one trigger date associated with said identified lien, the trigger date indicative of when the identified lien is required to be released by a lien holder associated with the identified lien or a lien status identification component having means for determining that the identified lien is required to be released and has not been released by the trigger date. MERS II teaches a lien management component having means for providing a user interface, receiving at least one lien release tracking request, identifying a lien corresponding to said request, and calculating at least one trigger date associated with said identified lien, the trigger date indicative of when the identified lien is required to be released by a lien holder associated with the identified lien (MERS II, Page 5, "A method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset." and Page 6, MERS can electronically transmit payoff amounts and other release information, Maher says. Until then, they are hoping MERS will enforce lien release requirements.")

and MERS teaches a lien status identification component having means for determining that the identified lien is required to be released and has not been released by the trigger date (MERS II, Page 5, "He notes that all parties will more easily be able to track loans to ensure that contractual obligations are being met." and Page 6, MERS can electronically transmit payoff amounts and other release information, Maher says. Until then, they are hoping MERS will enforce lien release requirements.").

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of MERS II with Feinberg. Both references relate to lien tracking and their management. MERS II teaches about a system which generates an 18 digit mortgage identification number (MIN) for every origination. This MIN will stay with a loan throughout its life-even as ownership of the loan and its servicing changes hands. (MERS II, Page 1). The reason for this 18 digit mortgage identification number is to prevent cases where the mortgages have been paid off but in which no one files to release the lien. Feinberg teaches a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset." (Feinberg [abs]). It would have been obvious at the time of the invention to have combined the MERS system with Feinberg in order to facilitate the management of these liens in order to avoid the pitfalls that often occur when the underlying note is bought, sold, transferred, securitized and so forth in

accordance with market custom, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

16. With respect to **Claim 17:**

Feinberg discloses wherein issuing said at least one trigger document includes displaying said trigger document in electronic form via said interface (Feinberg [0012], "The data is transmitted using email communication protocols.").

17. With respect to **Claim 18:**

Feinberg discloses wherein issuing said at least one trigger document includes printing said trigger document (Feinberg [0007], "For agencies that do not accept electronic filing, a paper copy of the legal instrument printed.").

18. With respect to **Claim 19:**

Feinberg discloses wherein said identified lien includes lien information including at least one of a lien holder, an obligor, a loan amount, a payee identifier and a lien jurisdiction (Feinberg [0011], "In the preferred embodiment for medical lien filing, the client is a medical service provider such as a physician, hospital, or therapist.").

19. With respect to **Claim 20:**

Feinberg discloses wherein said storage component includes at least one demand letter intended for a lien holder and at least one legal form adapted according to a jurisdiction associated with said identified lien (Feinberg [0012], "The guidelines set forth the content and format of the information required to properly file a lien in each

given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

20. With respect to **Claim 21:**

Feinberg discloses wherein said lien management component provides access to electronic records for at least one lien record-keeping jurisdiction (Feinberg [0012], “The guidelines set forth the content and format of the information required to properly file a lien in each given jurisdiction. The guidelines are compiled from statutes, regulations, and local practice for each locale.”).

21. With respect to **Claim 22:**

Feinberg discloses wherein said trigger date is calculated by determining statutory requirements for lien releases based on said identified jurisdiction (Feinberg [0002], “The process ensures that the patient or available insurance coverage pay the service or equipment provider its share of the reimbursement, once the insurance company settles or disburses finds related to the liability claim which caused the patient's injuries.” and [0007], “The present invention provides a method and system for automating the preparation, recordation, tracking and filing of liens, assignments, and other legal documents relating to securing payment of a debt or other obligation or transfer of ownership of an asset.”).

22. With respect to **Claim 23:**

Feinberg discloses wherein said statutory requirements are stored in a database and are accessible via network connection (Feinberg, [abs], “Certain lien information is provided by a lien holder to a centralized database via the Internet.”).

23. With respect to **Claim 24:**

Feinberg discloses further including means for updating said statutory requirement database (Feinberg [0004], "Once the lien documents are properly prepared and subsequently accepted by the government...") (Examiner notes that the government agency would not accept the lien documents unless they are properly filed. Therefore, the statutory requirement database would need to be updated.).

24. With respect to **Claim 25:**

Feinberg discloses wherein said at least one trigger document is an e-mail (Feinberg [0012], "The data is transmitted using email communication protocols.").

25. With respect to **Claim 26:**

Feinberg discloses wherein said at least one trigger document is a notice to at least one of a title company or lender (Feinberg [0015], "Similarly, the lien holder is notified that the claim has been perfected.").

26. With respect to **Claim 27:**

Feinberg discloses wherein said storage component further includes at least one form and at least one report, said form and said report being customizable based on said identified lien (Feinberg [0017], "The present invention can be applied to other types of liens").

27. With respect to **Claim 28:**

Feinberg discloses wherein said lien release tracking request includes lien transaction information received via a remote device over a network (Feinberg [0006], "It is a further object of this invention to provide a lien management system which

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operates on a computer network to accommodate multiple clients, recording agencies, and changing recording guidelines.”).

28. With respect to **Claim 29**:

Feinberg discloses wherein access is provided to a plurality of lien record databases corresponding to a respective plurality of lien record-keeping jurisdictions (Feinberg [0006], “It is a further object of this invention to provide a lien management system which operates on a computer network to accommodate multiple clients, recording agencies, and changing recording guidelines.”).

Response to Arguments

29. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Meyers whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S. Meyers/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689